

REMARKS

The office action of August 31, 2006, has been reviewed and these remarks are responsive thereto. Claims 1 and 4-9 remain pending. Reconsideration and allowance of the instant application are respectfully requested.

Claims 1 and 4-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over King *et al.* (U.S. Patent No. 5,953,541, “King”) in view of Walker (U.S. Patent No. 6,528,741 B2, “Walker”).

In order to establish a *prima facie* case of obviousness under § 103(a), three criteria must exist: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim limitations. *See MPEP § 706.02 (j); In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

However, even assuming, without conceding, that the asserted combination of King and Walker is proper, the prior art references do not teach or suggest all the claim limitations as is required. For example, independent claim 1 recites, *inter alia*, “wherein the user presses the one alphanumeric key on the wireless telephone in order to provide said keystroke for selecting a character group, which is followed by the user scrolling through the characters step by step using another key on the keypad, of the wireless telephone, that becomes dedicated for scrolling when the wireless telephone is in an editor mode.” The Office Action alleges that King discloses scrolling through characters in the character group for appointing a desired character at col. 4, ll. 55-64. Even so, the scrolling disclosed in King is performed by the multi-tap method, i.e., tapping the key representing the character group a certain number of times to bring up the desired character. In contrast, claim 1 recites scrolling through characters step by step using another key (i.e., a key other than the key representing the character group) on the key pad. As such, King does not teach or suggest all of the limitations of claim 1. Walker fails to cure this deficiency of King. The Office Action alleges, at p. 3, that Walker further teaches in the Abstract and column 1 lines 55-67 and FIGURE 1, of a first key (3) used in conjunction with a second keys (2), used to scroll through characters step by step. Applicants respectfully disagree. Walker discloses the use of a combination of a second key (2) and a first key (3) to select a

predefined character corresponding to the combination of keys (i.e., 2 & 3), not scroll through a character group. Col. 2, ll. 11-20. That is, repeatedly pressing either first key (3) or a combination of second key (2) and first key (3) in Walker would not result in scrolling through characters of a character group. Notably, Walker is entirely devoid of the term “scroll” or “scrolling.”

Additionally, nowhere does King or Walker teach or suggest that the another key used for scrolling becomes dedicated for scrolling when the wireless telephone is in an editor mode. The Office Action concedes, at p. 3, that King fails to disclose wherein a one of the alphanumeric keys becomes dedicated for scrolling. Walker does not cure this deficiency of King. Specifically, Walker discloses that the first key (3) (i.e., the alleged key used for scrolling) may be used to implement control functions such as “on-hook,” “off-hook,” initiating transmission of messages and viewing received messages. Col. 1, line 67 – Col. 2, line 9. As such, Walker teaches away from the first key (3) being a dedicated key for scrolling when the wireless telephone is in an editor mode. Claim 1 is thus allowable for at least the foregoing reasons.

Claim 5 recites, *inter alia*, “wherein the scroll key is one of the alphanumeric keys and becomes dedicated for scrolling when said terminal is in an editor mode, the scroll key enables scrolling of the different characters associated with each occurrence of a keystroke of an alphanumeric key following the pressing and release of each said alphanumeric key.” As discussed with respect to claim 1, King describes a multi-tap method where a key representing a character group is also used for scrolling. Thus, King does not teach or suggest a dedicated scroll key for scrolling of different characters associated with each occurrence of a keystroke of an alphanumeric key, as is recited in claim 5. Further, Walker does not cure this deficiency of King. Walker teaches using a combination of buttons to select desired characters. Significantly, Walker lacks any teaching or suggestion of scrolling or dedicated scroll keys. Claim 5 is thus allowable for at least these reasons.

Claim 7 recites, *inter alia*, “wherein the scroll key is one of the alphanumeric keys and becomes dedicated for scrolling when said wireless telephone is in an editor mode, the scroll key enables scrolling of the different characters associated with each occurrence of a keystroke of an alphanumeric key following the pressing and release of each said alphanumeric key.” As previously discussed, King is directed to a multi-tap method for scrolling and Walker lacks any

teaching or suggestion of scrolling, much less a dedicated scroll key. Accordingly, claim 7 is allowable for at least this reason.

Furthermore, there is no motivation or suggestion to combine King and Walker. The Office Action states that it would have been obvious to combine the references to "allow a user to selectively input characters for a desired text string in a mobile phone." However, neither Walker nor King teach or suggest a need or desire for a dedicated scroll key for scrolling through a character group represented by an alphanumeric key. As such, the Office Action's asserted motivation is not a motivation to combine references, but rather is the conclusion the examiner has apparently reached after having benefited from reading Applicant's own disclosure, and is thus impermissible hindsight.

Based on the foregoing, Applicant respectfully submits that the application is in condition for allowance and a Notice to that effect is earnestly solicited. Should the Examiner believe that anything further is desirable in order to place the application in even better form for allowance, the Examiner is respectfully urged to contact Applicant's undersigned representative at the below-listed number.

Respectfully submitted,

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